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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,889	03/31/2004	Ori Gerstel	100101-000300US	9087

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Trellis Intellectual Property Law Group, PC  
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PALO ALTO, CA 94303

EXAMINER
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ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2455

NOTIFICATION DATE	DELIVERY MODE
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10/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/815,889	<b>Applicant(s)</b> GERSTEL ET AL.	
	<b>Examiner</b> DAVID Y. ENG	<b>Art Unit</b> 2455	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-15,21,22,24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, 21-22, 24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 2, 16-20, 23 and 25 have been cancelled. Newly submitted claim 28 has been entered. The active claims are 1, 3-15, 21-22, 24 and 26-28 of which claims 1, 21, 22 and 24 are independent claims.

#### **Section 112, 1st paragraph Rejection**

In the amendment submitted on 9/20/2009, Applicants delete the recitation “using a network planning tool prior to a time of operation of the digital network to define a plurality of recommended routes”, and the recitation “determining when a route change is needed at the time of operation of the digital network” from independent claims 1, 21, 22 and 24. Applicants also inserted the deleted recitation “the list of recommended routes is generated prior to a time of operation of the digital network” in dependent claim 10.

Applicants further pointed out in the communication submitted on 9/20/2009 that [0016] discloses that the network planning tool is prior art. The Section 112, 1<sup>st</sup> paragraph Rejection based on lack of disclosure of the network planning tool therefore is withdrawn.

#### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-15, 21-22, 24 and 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to independent claims 1, 21, 22, 24, 11 and 12, the specification fails to define what recommended routes are. The specification fails to disclose how to obtain recommended routes. The specification further fails to disclose how to obtain the recommended routes prior to a time of operation of the digital network. Without the recommended routes, generating a list of the recommended routes is impossible.

With respect to claim 28, paragraph [20] merely set forth what to expect from the specification. The paragraph does not detail an optical engineering aspects of a hybrid network and how that would allow process at the operation stage to take advantage of sophisticated simulation results from planning tools to determine problems such as regeneration of a signal along an optical path.

## **Response**

The Examiner has carefully studied [0016]. Paragraph [0016] does not disclose how to obtain the recommended routes prior to a time of operation of the digital network.

Applicants admitted on page 8, last paragraph of the communication filed on 9/20/2009 that the Cisco MetroPlanner merely describes some aspects of routing

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strategies such as maximum number of allowed connectivity and that the Cisco MetroPlanner and other prior art planners do not teach or suggest a list of recommended routes. Without the recommended routes on hand, one of ordinary skill in the art would not be able to practice the invention without undue experiments.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Scope of claim 28 is not clear. There is no functional relationship between the step of claim 8 and the steps of its parent claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 3, 5-8, 13, 21, 22, 26 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Blouin et al. (USP 7,249,169.

See at least the abstract of Blouin. Blouin teaches creating a route list listing a plurality of routes. A node in the network of Blouin is allowed to choose the best available route from the route list.

**Claims 1, 21-22, 24**

A method for allocating a recommended route in a digital network, the method comprising:

generating a list of recommended routes (abstract in Blouin, creating a route list), sending the list of recommended routes to a network device in the digital network; selecting, by the network device, one of the recommended routes (abstract, the network node in Blouin obtains the route list from the route list source and select the best available route from the route list); and

monitoring, by the network device, performance of the list of recommended routes at the time of operation of the digital network (see the terms “measuring”, “monitoring” and “performance” in line 18 of the abstract, lines 20-27, 48, 64 and 66 of column 1; lines 5 and 41 of column 2 of Blouin).

**Claim 3, 5, 6, 7, 8, 13, 26**

The claims consist of non-functional descriptive materials and are not patentably distinct over Blouin. The recitations are descriptive in nature and have no functional effect on anyone step of their parent claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) in view of Moure (USP 7,219,159).

**Claims 4, 27**

Blouin teaches claim combination set forth above. Blouin does not prioritize the routes. Prioritizing routes is well known in the network communication art. See column 6 line 36-39. Moure teaches prioritizing routes in a route list. From the teaching of Moure, it would have been obvious to a person of ordinary skill in the art to prioritize the routes so that routes can be selected for use in accordance with priority.

***Claim Rejections - 35 USC § 103***

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169).

**Claim 9,**

Blouin teaches claim combination set forth above. Blouin does not explicitly teach generating an alternative routing list. Knowing how to generate an initial routing list, generating another one is notoriously obvious. Blouin teaches monitoring performance

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of the list also. It is well known in the purpose of monitoring is to improve what is monitored. It would have been obvious to a person of ordinary skill in the art to improve the system of Blouin by generating an alternative routing list if the original routing list does not meet the performance requirement monitored.

**Claim 10,**

As admitted by Applicants, generating a list of routes prior to a time of operation of the digital network is well known in the art. Applicants admitted that the tools listed in [0016] are prior art.

**Claims 11, 12**

The definition (resource list) is sent to which ever devices need the resource regardless what the names of the devices are.

***Claim Rejections - 35 USC § 103***

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) in view of Garfinkel (USP 5,408,600).

**Claims 14, 15,**

Blouin teaches claim combination set forth above. Blouin does not update his list. Updating a resource list is well known in the network communication art. See the abstract line 17-18 in Garfinkel. From the teaching of Garfinkel, it would have been obvious to a person of ordinary skill in the art to update the list so that the list is more current and complete.



## **Claim 28**

For the reasons set forth in the Section 112, Rejections above, no statement can be made as to whether Blouin is applicable.

## **Response**

Applicants broadly claim the outlines for research and development shown in Figure 2. Applicants did not provide any arguments as to why the claims as amended are patentably distinct over the applied references as required by 37 CFR 1.111c. The court held that simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. *In re Nielson*, 816 F.2d 1567, 2 USPQ 1525 (Fed. Cir. 1987).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/

Primary Examiner, Art Unit 2455